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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,336	04/01/2004	Andrew Greaves	05725.1348-00	5352

22852 7590 06/21/2006

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EXAMINER	
ELHILO, EISA B	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/814,336	GREAVES ET AL.	
	Examiner	Art Unit	
	Eisa B. Elhilo	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-99* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *41-50 and 89-99* is/are allowed.

6)☒ Claim(s) *1-6 and 51-56* is/are rejected.

7)☒ Claim(s) *7-40 and 57-88* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/11/06&5/30/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1 This action is responsive to the amendment filed on April 11, 2006.

2 The double patenting rejection of claims 1-6 and 51-56 is maintained for the reasons set forth in the previous office action that mailed on 11,17,2005.

3 The rejection of claims 51-56 under 35 U.S.C. 102(b) as being anticipated by Degen et al. (US' 458), is maintained for the reasons set forth in the previous office action that mailed on 11,17,2005.

4 The rejection of claims 1-6 under 35 U.S.C. 103(a) as being unpatentable over Degen et al. (US' 458), is maintained for the reasons set forth in the previous office action that mailed on 11,17,2005.

5 The objection of claims 7-40 and 57-88, is maintained for the reasons set forth in the previous office action that mailed on 11,17,2005.

6 Claims 41-50 and 89-99 are allowed for the reasons set forth in the previous office action that mailed on 11,17,2005.

Response to Applicant's Arguments

7 Applicant's arguments filed 4/11/2006 have been fully considered but they are not persuasive.

With respect the rejection of the claims under 35 U.S.C. 102(b) as being anticipated by Degen et al. (US' 458), Applicant argues that Degen et al. does not anticipate the claims because Degen et al. teaches methine dyes for dyeing paper and modified fibers and does not teach or disclose a composition comprising in a cosmetically acceptable medium at least one fluorescent dye presents in an amount sufficient to dye keratin material wit a lighting effect.

The examiner respectfully disagrees with the above arguments because in order to constitute anticipatory prior art, a reference must identically disclose the claimed compound, but no utility be disclosed by the reference. *In re Schoenwald,* 964 F.2d 1122, 22 USPQ2d 1671 (Fed. Cir. 1992) (The application claimed compounds used in ophthalmic composition to treat dry eye syndrome. The examiner found a printed publication, which disclosed the claimed compound but did not disclose a use for the compound. The court found that the claim was anticipated since the compound and a process of making it was taught by the reference. The court explained, "no utility need be disclosed for a reference to be anticipatory of a claim to an old compound."964 F.2d at 1124, 22 USPQ2d at 1673. It is enough that the claimed compound is taught by the reference. In this case Degen et al. teaches a dye compound (see cols 13-14, Example 6) having a formula which reads on the claimed formula, when in the claimed formula, a = 1 and X is an ethyl radical (unsubstituted hydrocarbons). Therefore, the anticipation rejection is proper and maintained.

8 With respect to the rejection of the claims under 35 U.S.C. 103(a) as being unpatentable over Degen et al. (US' 458), Applicant argues that Degen et al. teaches methine dyes for dyeing paper and modified fibers and does not teach or disclose a composition comprising in a cosmetically acceptable medium at least one fluorescent dye presents in an amount sufficient to dye keratin material wit a lighting effect.

The examiner respectfully disagrees with the above arguments because the recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the

claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto,* 136 USPQ 458, 459 (CCPA 1963). Further, the recitation of a new intended use for old product dose not make a claim to that old product patentable. (*In re Schreiber*, 44 USPQ 2d 1429 (Fed. Cir. 1997). In this case Degen et al. teaches a dye compound that reads on the claimed formula and whereas the dye compound is used in a composition for dyeing fibers, and, thus, there is a sufficient modification to one having ordinary skill in the art to use the dye in composition for dyeing keratin fibers. Therefore, the prima facie case of obviousness has been established and the rejection is mainmtained.

Further, Applicant has not shown on record the criticality of the claimed composition over the composition of the prior art.

9 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eisa Elhilo
Primary Examiner
Art Unit 1751

June 10, 2006